

Remarks

Claims 20-51 and 62-88 were previously withdrawn from consideration.

The current Office Action rejected claims 1-9, 11-13 and 16 under 35 U.S.C. Section 102 (b) as being anticipated by Hoffman, U.S. Pat. No. 4,327,912. Claims 10, 14-15, 17-19 and 52-61 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Hoffman in view of Copenhaver et al., U.S. Pat. No. 5,720,734.

The Examiner is respectfully thanked for the careful review of this application as evidenced by the thorough office action that included explicit explanations of the various rejections. Also, the Examiner is respectfully thanked for withdrawing the previous rejections and objections.

Applicants mailed a Supplemental Information Disclosure Statement in this case on March 4, 2003, but the most recent Office Action did not return an initialed copy. Applicants respectfully request that an initialed copy be returned with the next official action. Also, a Supplemental Information Disclosure Statement was mailed on August 11, 2003 for this case. Applicants also request that an initialed copy of that SIDS be returned with the next official action.

With respect to the rejection based solely on Hoffman, a patent is invalid for anticipation if a single prior art reference discloses each and every limitation of the claimed invention. Lewmar Marine, Inc. v. Barient, Inc., 827 F.2d 744, 747 (Fed. Cir. 1987). This is not the case with Hoffman for several reasons. For example, the present invention comprises an implantable balloon. The implantable balloon is inflated under strictly controlled, sterile conditions. In a preferred embodiment, the implantable balloon is inflated *in vivo*. The contrast between the preset invention and Hoffman is clear.

Hoffman discloses a game ball. The game ball is placed in a canister of a fixed volume at the unclean play site. The canister is then sealed and compacted to a lesser volume. The change in volume subjects the ball to pressure which will impart the desired bounce characteristics. See column 3, lines 7-35 of Hoffman.

It is noted that the word "implantable" appears in the preamble of applicant's independent claims. Whether to treat a preamble as a claim limitation is determined on the facts of each case in light of the claim as a whole and the invention described in the patent. See Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 808, 62 USPQ2d 1781, 1784 (Fed. Cir. 2002). Applicant's specification mentions that medical balloons may be utilized to treat stress urinary incontinence and other medical disorders. See page 1,

paragraphs [0003] and [0005] of applicant's specification. The invention is clearly related to implantable medical balloon used for medical purposes, not a game ball such as a tennis ball. Thus, the rejection of the independent claims (e.g. 1 and 11) based on 35 U.S.C. Section 102 (b) should be withdrawn.

Copenhaver et al. does not cure the deficiencies of Hoffman. Copenhaver et al. discloses a gastrotomy port or a one-way entrance seal for medical catheters. Thus, even if all of the teachings of Copenhaver et al. and Hoffman are combined, they still fail to teach the present invention set forth in claims 1 and 11.

Claim 52 recites a valve stem with a rounded tip. Claim 52 also recites that the piercing has a bend that curves toward the stem side. None of these features are cited in any of Hoffman and Copenhaver et al. Figure 2 of Copenhaver et al. is referenced in the Office Action, but this Figure fails to disclose a valve stem with a rounded tip and other limitations. Thus, even if all of the teachings of these references are combined, they fail to teach the present invention as claimed in claim 52.

It is respectfully submitted that one of ordinary skill in the art would not look to the field of gastrotomy feeding ports in order to modify a game ball. Thus, there is no incentive, suggestion, reason or motivation to combine Copenhaver et al. and Hoffman to arrive at the present invention. As a result, it is respectfully submitted that this case is in condition for allowance.

With respect to the restriction requirement, applicants respectfully submit that it is unduly harsh. The restriction requirement is tantamount to requiring five different patent applications for claims 1-88 of the present application. It is respectfully submitted that the patent owner and public would be better served if the restriction requirement were withdrawn or at least modified to include more claims in this case. Reconsideration or at least partial modification is respectfully requested. However, should this response result in the indication of allowable subject matter, applicants agree to cancel the non-elected claims in order to expedite the grant of a patent.

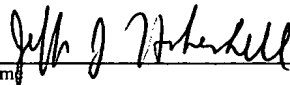
The dependent claims further recite patentable features, but are also allowable in light of their allowable independent claims.

Examination and reconsideration of the application is requested.

If the Examiner comes to believe that a telephone conversation may be useful in addressing any remaining open issues in this case, the Examiner is urged to contact the undersigned attorney at 952-930-6135.

Registration Number	Telephone Number
34,109	(952) 930-6135
Date	
October 9, 2003	

Respectfully submitted,

Signature

Printed Name
Jeffrey J. Hohenshell

**Office of Intellectual Property Counsel
AMS Research Corporation
10700 Bren Road West
Minnetonka, MN 55343**